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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

Application No. : 09/862,502 Confirmation No.: 7223
Applicant : Gerhard Dittrich
Filed : May 23, 2001
Title : METHOD FOR PROVIDING MEASURED VALUES
FOR END CUSTOMERS
TC/A.U. : 3621
Examiner : C.O. Sherr
Docket No. : DITT3001 /FJD
Customer No. : 23364

REPLY BRIEF ON APPEAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22202-3514

Sir:

INTRODUCTORY COMMENTS

Pursuant to the provisions of 37 CFR 41.41, submitted herewith is
Applicant/Appellant's Reply Brief on Appeal.

In the Examiner's Answer, the examiner states on page 10:

....in Mulokey (e.g. abs) each address count is incremented by one after each group of bits is received, thus in effect counting the number of transmission operations. Thus, the claims recite combinations which only unite old elements with no change in their respective functions and which yield predictable results.

It is respectfully submitted that the conclusion does not follow the premise. That is, why is the combination of steps (not elements) recited in the pending method claims "old" simply because one reference in a combination of three references may teach one of several steps claimed, and that assumes that the reference (Mulokey does even teach one step? No reason is given, except to refer to **KSR**. But in the **KSR** case the court stated at p. 1389 (of 82 USPQ2d):

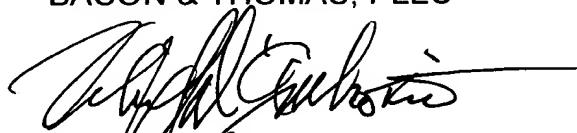
A court [and in our case the USPTO] must ask whether the improvement is more than the predictable use of prior-art elements [steps] according to their established functions.....
To determine whether there was an apparent to combine the known elements [steps] in the way a patent claims, it will often be necessary to look to interrelated teachings of multiple patents; ***to the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art.***
(emphasis added).

Where has an analysis which takes the above factors into consideration been made in this prosecution? It cannot be found. Obviousness has merely been concluded without, it is respectfully submitted, sufficient justification.

The Board is respectfully requested to consider the above in its deliberation as well as Applicant/Appellant's Brief-in-Chief.

Respectfully submitted
BACON & THOMAS, PLLC

Date: May 13, 2008



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